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10/681,724

10/08/2003

Robert H. Kummer JR.

F-725

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7590

05/01/2007

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EXAMINER

VETTER, DANIEL

ART UNIT

PAPER NUMBER

3628

MAIL DATE

DELIVERY MODE

05/01/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/681,724 | <b>Applicant(s)</b><br>KUMMER ET AL. |  |
|                              | <b>Examiner</b><br>Daniel P. Vetter  | <b>Art Unit</b><br>3628              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 11-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

Claims 1-10 have been canceled. Claims 11, 12, 14, and 19 have been amended. Claims 11-20 are currently pending in this application.

#### *Response to Amendment*

1. Applicant's amendment to the Specification is sufficient to overcome the objection to the drawings. The drawings are accepted by the Examiner.
2. Applicant's amendment to claims 11 and 19 overcome their objections and they are withdrawn.
3. Applicant's amendment to claims 12 and 14 overcome their rejections under 35 U.S.C. § 112, second paragraph and these are withdrawn as to claims 12 and 14-17.

#### *Response to Arguments*

4. Applicant's arguments filed February 12, 2007 have been fully considered but they are not persuasive.

Applicant argues that because, in Kulik, the user selects a rate table it does not teach selecting a class of service. However, Applicant admits in page 8 of Remarks submitted February 9, 2007 that Kulik teaches the user inputs a rates template used for processing mail pieces. Kulik therefore teaches the user selects a class, as the claimed invention was not directed to doing so without the use of a rate table that was not initially created by the user. Merely because in Kulik, the user selects a class for mail

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pieces in initially creating a rate table and then later selects that rate table does not mean it lacks a teaching that the class is selected by the user. Applicant similarly argues that because the processing step of determining the propriety of a class is done solely by weight in Kulik, that it does not teach the rating is based upon a class selected by the user. However this argument is also not persuasive because the rating in Kulik is done based upon the template which the user initially created (column 3, lines 15-16); and therefore not solely on weight. This line of reasoning also applies to the argument that Kulik does not teach determining a second class of service, as there is nothing in the claimed invention which prevents this from reasonably occurring during the initial setup of the rate table, as taught by Kulik, which teaches doing so with multiple class determinations (column 6, lines 43-46).

*Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 11-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kulik, U. S. Pat. No. 5,842,186 (Reference AC of the IDS submitted on 10/08/2003) in

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view of Ramsden, et al., U.S. Pat. No. 5,831,220 (Reference A of the PTO-892 part of Paper No. 20061101).

3. As per claim 11, Kulik teaches a mail processing system for processing a mail piece comprising: a postage meter for applying postage values to said mail piece (column 5, line 15); a scale for weighing said mail piece (column 5, line 14); a central processing unit controlling operation of said postage meter and said scale (column 5, line 19-20); and a memory storing postage rating information (column 5, lines 21, 34-35) and software executable by said central processing unit (column 5, line 20), said software including instructions for performing: receiving a first class of service from a user for processing said mail piece (column 4, lines 58-59); determining a weight of said mail piece using said scale (column 4, lines 60-61); determining whether said first class of service received from said user is appropriate for said mail piece using said determined weight and other parameter (column 8, lines 38-41), and if said first class of service is not appropriate, determining a second class of service for said mail piece using said determined weight and other parameter (column 8, lines 41-44), said second class of service being appropriate for said mail piece (column 8, lines 41-44); setting a final class of service for said mail piece (column 8, line 40), said final class of service being said first class of service if said first class of service is determined to be appropriate and said second class of service if said first class of service is determined

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to not be appropriate (column 8, lines 38-44; column 7, lines 16-25); and determining a postage amount for said mail piece using said determined weight, at least one dimension, said final class of service and said postage rating information (column 5, lines 3-6; column 7, lines 50-53). Kulik does not teach a dimensioning module for determining at least one dimension of said mail piece, does not teach the central processing unit controlling said dimensioning module, and does not teach determining at least one dimension of said mail piece using said dimensioning module. Ramsden, et al. teaches a dimensioning module for determining at least one dimension of said mail piece (column 16, lines 1-3), the central processing unit controlling said dimensioning module (column 17, lines 20-21); determining at least one dimension of said mail piece using said dimensioning module (column 16, line 31). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate a dimensioning module for determining at least one dimension of said mail piece, the central processing unit controlling said dimensioning module; determining at least one dimension of said mail piece using said dimensioning module; into the system taught by Kulik because dimensions are used to determine postage charges (as taught by Ramsden, et al., column 2, lines 49-52).

4. As per claim 12, Kulik in view of Ramsden, et al. teaches the system of claim 11 as described above. Kulik further teaches the software further includes instructions for

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causing said postage meter to apply said determined postage amount to said mail piece or a tape to be applied to said mail piece (column 5, lines 28-33).

5. As per claim 13, Kulik in view of Ramsden, et al. teaches the system of claim 11 as described above. Ramsden, et al. further teaches receiving one or more special services to be applied to said mail piece (column 2, lines 54-55). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate receiving one or more special services to be applied to said mail piece into the system taught by Kulik in view of Ramsden, et al. because many deliverers offer special services for a premium price (as taught by Ramsden, et al., column 1, lines 31-32).

6. As per claim 14, Kulik in view of Ramsden, et al. teaches the system of claim 13 as described above. Ramsden further teaches determining whether each of said special services is applicable to said mail piece using said postage rating information, said postage rating information including special service availability information, and generating a list of applicable special services for said mail piece (column 2, lines 49-53). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate determining whether each of said special services is applicable to said mail piece using said postage rating information, said postage rating information including special service availability information, and generating a list of

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applicable special services for said mail piece into the system taught by Kulik in view of Ramsden, et al. because many deliverers offer special services for a premium price (as taught by Ramsden, et al., column 1, lines 31-32).

7. As per claim 15, Kulik in view of Ramsden, et al. teaches the system of claim 14 as described above. Kulik further teaches determining a postage amount for said mail piece using said determined weight, said determined at least one dimension, and said final class of service (column 5, lines 1-8). Kulik does not teach determining a postage amount for said mail piece using said list of applicable special services. Ramsden, et al. teaches determining a postage amount for said mail piece using said list of applicable special services (column 2, lines 52-53). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate determining a postage amount for said mail piece using said list of applicable special services into the system taught by Kulik in view of Ramsden, et al. because many deliverers offer special services for a premium price (as taught by Ramsden, et al., column 1, lines 31-32).

8. As per claim 16, Kulik in view of Ramsden, et al. teaches the system of claim 14 as described above. Ramsden, et al. further teaches determining whether each of said special services is applicable to said mail piece is based on said final class of service, said determined weight, said determined at least one dimension, and a determination as



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to whether all applicable prerequisite requirements have been satisfied (column 21, lines 6-14). Examiner is interpreting determining if a service option is "available" as determining whether all applicable prerequisite requirements have been satisfied. It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate determining whether each of said special services is applicable to said mail piece is based on said final class of service, said determined weight, said determined at least one dimension, and a determination as to whether all applicable prerequisite requirements have been satisfied into the system taught by Kulik in view of Ramsden, et al. because many deliverers offer special services for a premium price (as taught by Ramsden, et al., column 1, lines 31-32).

9. As per claim 17, Kulik in view of Ramsden, et al. teaches the system of claim 14 as described above. Ramsden, et al. further teaches the software further includes instructions for storing transaction information for said mail piece in said memory (column 10, lines 8-9). The limitation "said transaction information including said determined postage amount and said final class of service" is a recitation of the non-functional descriptive material (i.e., transaction information) stored on the memory and is afforded no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *In re Gulack*, 703 F.2d 1381, 1385; 217 USPQ 401, 404 (Fed. Cir. 1983). It would have been prima facie

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obvious to one having ordinary skill in the art at the time of invention to incorporate the software further includes instructions for storing transaction information for said mail piece in said memory into the system taught by Kulik in view of Ramsden, et al. in order to maintain a package history log (as taught by Ramsden, et al., column 10, line 42).

10. As per claim 18, Kulik in view of Ramsden, et al. teaches the system of claim 11 as described above. Ramsden, et al. further teaches the software further includes instructions for storing transaction information for said mail piece in said memory (column 10, lines 8-9). The limitation "said transaction information including said determined postage amount, said final class of service and said list of applicable special services" is a recitation of the non-functional descriptive material (i.e., transaction information) stored on the memory and is afforded no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *In re Gulack*, 703 F.2d 1381, 1385; 217 USPQ 401, 404 (Fed. Cir. 1983). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the software further includes instructions for storing transaction information for said mail piece in said memory into the system taught by Kulik in view of Ramsden, et al. in order to maintain a package history log (as taught by Ramsden, et al., column 10, line 42).

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11. As per claim 19, Kulik in view of Ramsden, et al. teaches the system of claim 11 as described above. Kulik further teaches determining whether said first class of service supports said determined at least one parameter (column 8, lines 38-39; Tables 1-3) and, if not, finding a third class of service that supports said determined at least one parameter (column 8, lines 41-43; Tables 1-3); determining whether one of said first class of service and said third class of service, if applicable, supports said determined weight (column 8, lines 38-43; Tables 1-3) and, if not, finding a fourth class of service that support said determined weight (column 8, lines 45-46; Tables 1-3); setting said second class of service equal to said third class of service if said first class of service does not support said at least one parameter and said third class of service supports said weight (column 7, lines 21-23; column 8, lines 41-43; Tables 1-3); and setting said second class of service equal to said fourth class of service if neither of said first class of service and said third class of service, if applicable, support said determined weight (column 7, lines 21-23; column 8, lines 45-46; Tables 1-3); wherein said first class of service is appropriate if said first class of service supports said determined weight (column 7, lines 18-21; column 8, lines 38-39; Tables 1-3). Kulik further teaches that a dimension is a parameter, along with weight, that is used to determine appropriate classes of mail (column 5, lines 1-4).

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12. As per claim 20, Kulik in view of Ramsden, et al. teaches the system of claim 19 as described above. Kulik further teaches determining said third class of service and said fourth class of service based on predetermined rules for switching classes (column 6, lines 44-45; Tables 1-3). Examiner is interpreting a rates manager with break points for each selected class as predetermined rules for switching classes.

*Conclusion*

13. Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the Applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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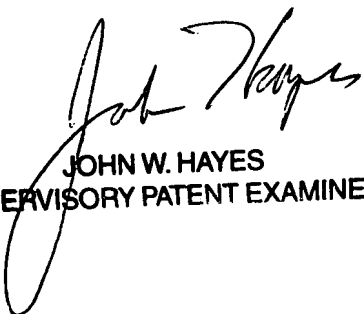
mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel P. Vetter whose telephone number is (571) 270-1366. The examiner can normally be reached on Monday through Thursday from 8am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



JOHN W. HAYES  
SUPERVISORY PATENT EXAMINER